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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 13

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Appellant(s): Stephen W. Comiskey et al.

95-3656
Robert A. Vanderhye
For Appellant

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BOARD OF PATENT APPEALS
AND INTERFERENCES

EXAMINER'S ANSWER

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This is in response to appellant's brief on appeal filed
February 17, 1995.

(1) *Status of claims.*

The statement of the status of claims contained in the brief
is correct.

(2) *Status of Amendments After Final.*

The appellant's statement of the status of amendments after
final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 02/17/95 has
been entered.

(3) *Summary of invention.*

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The summary of invention contained in the brief is correct.

(4) *Issues.* The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The examiner withdraws the rejection of claims 1, 12, 13 and 16 under 35 U.S.C. §112, second paragraph on the grounds that the phrase "location...at which...light is likely to be reflected", as recited in claim 1, is vague and indefinite.

Accordingly, the issue of whether or not the claims are indefinite for failing to particularly point out and distinctly claim the subject matter as required by 35 U.S.C. §112, second paragraph, pertains only to claims 2, 6-11 and 17-19.

(5) *Grouping of claims.*

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with. In particular, claims wherein the differences lie in the particular shape of the non-toxic material are not patentably distinct from each other. For example, the only difference between claims 1 and 12 is the shape of the non-toxic material. The only difference between claims 2, 8 and 11 is the shape of the non-toxic material. The only difference between claims 17 and 18 is the shape of the non-toxic material. These differences are not sufficient to render the claims patentably distinct from each other.

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On the issue of the obviousness of claims 1, 2 and 8-12 over the conventional use of eye black, it is the examiner's position that claims 1, 2 and 8-12 stand or fall together.

On the issue of the obviousness of claims 1, 2, 6-13 and 16-19 over temporary tattoos as exemplified by the supplied brochures, it is the examiner's position that method claims 1, 2, 6-13 and 16 stand or fall together with the rejection of claim 1 and that product claims 17-19 stand or fall together with the rejection of claim 17.

(6) *Claims appealed.*

The copy of appealed claims 1, 6, 7, 10-13, 16, 17 and 19 contained in the Appendix to the brief is correct.

A substantially correct copy of appealed claim 2 appears on page 23 of the Appendix to the appellant's brief. The minor errors are as follows: In line 3 of claim 2, the phrase "material substantially eliminates" should read --material and its location substantially eliminate--.

Claims 8, 9 and 18 contain substantial errors as presented in the Appendix to the brief. Accordingly, claims 8, 9 and 18 have been correctly written in the Appendix to the examiner's answer.

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(7) *Prior Art of record.*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Sports Illustrated, January 10, 1994, front cover.

"The Original Temporary Tattoos_{TM}" brochure, J.B. Marketing, Inc., 1993.

"Game Faces" brochure, Team Dynamics, 1993.

Anderson's 1993-1994 catalog, pp. 61-63, "Cheek Cheers".

(8) *New prior art.*

No new prior art has been applied in this examiner's answer.

(9) *Grounds of rejection.*

The following ground(s) of rejection are applicable to the appealed claims.

(a) *Rejection of claims 2, 6-11 and 17-19 under 35 U.S.C. §112, second paragraph.*

Claim 2: The phrase "substantially eliminate reflection" is unclear. How much light can be reflected and still be considered to be substantially eliminated? Is it possible for direct light to be reflected but not indirect light or vice versa? The claim recites "the material and its location substantially eliminate reflection of incident direct or indirect

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light" (emphasis added). If the location for reflection of direct light is different than the location for reflection of indirect light, this difference is pertinent to these claims. The claimed method needs to be practiced so that at least one of these reflections is substantially eliminated. Could the material and its location substantially eliminate the reflection of one type of light, but not the other?

Appellants argue that the term "substantially" is used in the claims of hundreds of thousands of patents. The examiner is aware of this fact. However, it is the examiner's position that the definiteness and clarity of the term must be considered in the context in which it is used. In the context of the present claims, the phrase "substantially eliminate reflection" is unclear because the claims using this terminology do not clearly set forth how much reflection is allowed within the scope of "substantially" eliminating reflection.

Claims 9 and 19: The limitation regarding size in compliance with regulations is indefinite (e.g. claim 9 reciting "sized to comply with regulations of any regulatory body which overseas [sic] the athletic contest").

Appellants argue that the size limitation, as well as limitations regarding the material and its location are set forth in a "definition by result" format and are not indefinite.

The examiner respectfully disagrees. What if a limitation

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as defined by one result conflicts with a different limitation defined by a different result? For example, what if the size regulations would restrict the size to that which would be insufficient to provide a material and a location to "substantially" eliminate reflection, or insufficient to "substantially" cover the area of a reflective location?

What if more than one regulatory body oversees the contest, and each body has different size regulations?

Claims 9 and 10: It is unclear if the phrase "primarily black or dark colored" places any limitation with respect to amount of area. The term "primarily" is indefinite and not understood. For example, is a "primarily" black or dark colored area one in which at least 50% of the area is black or dark colored?

Claim 10: How much is "most" of the light?

Appellants state that the term should be interpreted as in the normal use of the term and that "most" means the majority of as defined in Webster's New Collegiate Dictionary, page 751, 1973. This does not define the scope of the claim. The "majority" may represent one amount in one situation but not in another. A candidate who wins an election by a majority of votes in a three candidate race may have gotten less votes than a candidate who wins by a majority in a two candidate race.

Claim 17: The limitation of "dimensioned to substantially

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cover the area" is indefinite. The area to be covered will vary with the size of the person.

The limitation of "sufficient to substantially eliminate" is unclear. (See related comments for claim 2.)

(b) Rejection of claims 1, 2 and 8-12 under 35 U.S.C. §103 as being unpatentable over the conventional use of eye black by athletes (as exemplified by the cover of Sports Illustrated, Jan. 10, 1994).

The use of eye black by athletes to minimize reflected light is old and is admitted as such on page 1 of the present specification. Appellants seek to distinguish the present claimed invention from this conventional practice by specifying that the non-reflective material is in the form of a "predefined clearly demarcated geometric shape which provides a non-verbal communication to others".

The conventional use of eye black provides a non-verbal communication in that someone seeing a person wearing eye black will likely come to the conclusion that the wearer is/was a participant in an athletic event.

Appellants reiterate that the language "predefined clearly demarcated geometric shape" has been ignored when evaluating the claims. Appellants argue that the terminology should be considered as a whole, not dissected into individual elements.

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Appellants argue that in applying conventional eye black, "one does not define or determine a clearly demarcated geometric shape in advance".

The limitation with regard to "predefined clearly demarcated geometric shape" is not seen as patentably distinguishing the present invention from the conventional use of eye black. As seen on the Sports Illustrated cover submitted with applicants' Information Disclosure, the eye black reasonably appears to be "clearly demarcated" in that it is clear where the eye black is applied versus where it is not applied. The area of eye black has a "shape". The terms "predefined" and "geometric" do not place any clear positive limitations on the shape. The term "geometric" adds nothing beyond the term "shape" and the term "predefined" adds no patentable limitations. Whether the applier of eye black defines the shape of application a minute before application or days before application, the shape has been predefined. In addition, as eye black is generally applied in the same shape, it is apparent that athletes have predefined the shape.

The application of eye black in a particular pattern/shape/design, as in claims 8-12, would be a matter of obvious design choice requiring only an expenditure of time, and possibly some artistic skill, on the part of the applier.

Appellants argue that the claim language regarding non-

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verbal communication is misinterpreted. Appellant argues that the shape, not the non-reflective material, provides the communication. Appellants argue that the shape, as shown on the Sports Illustrated cover, provides no non-verbal communication.

The examiner respectfully disagrees, noting that if the eye black were applied in a different shape, such as in a vertical straight line, a viewer may not arrive at the conclusion that the person wearing the eye black is an athlete. Contrary to Appellants' arguments, the eye black as shown on the cover of Sports Illustrated is a predefined clearly demarcated geometric shape which provides a non-verbal communication.

The examiner maintains the position that the application of the material in the shape of a logo, team name, mascot, or letters identifying a manufacturer or distributor is a design choice. The function achieved by using such shapes, i.e. identification of a team, manufacturer or distributor, is inherent in the use of the shape and is well-known. For instance, a company's trademarked logo is used by the company so that consumers can readily identify the company and product associated with the logo. The use of the material in the shape of a logo, team name, mascot or letters does not affect the non-reflectivity function of the material per se.

(c) Rejection of claims 1, 2, 6-13 and 16-19 under 35 U.S.C.

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§103 as being unpatentable over conventional temporary tattoos as exemplified by the Team Dynamics, J.B. Marketing, Inc., and Anderson's brochures of record.

The basic structure of appellants' temporary tattoo and the method of applying the temporary tattoo were known at the time of the invention.

Appellants seek to distinguish the presently claimed invention from known temporary tattoos by stating that the tattoo is placed in the area of the eye. As appellants point out, the directions of the back of the temporary tattoos from J.B. Marketing, Inc. state that the tattoo should not be applied near eyes. However, both the Team Dynamics brochure and the J.B. Marketing, Inc. brochure show people with temporary tattoos applied as close to their eyes as would be applied in the present invention, based on the general disclosure of what is considered to be the reflective area.

With respect to claims 17-19, the intended use of the temporary tattoo does not serve to patentably distinguish the claimed tattoo from known tattoos.

Appellants also seek to distinguish the presently claimed invention from known temporary tattoos by stating that the inventive tattoos comprise dull or matte black or dark colors. The advertising brochures show several black or dark color tattoos within the scope of the present invention's examples of

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"dark" colors. The pictures in the brochures appear to be shiny, however, it is uncertain whether the tattoos as applied would be shiny, particularly in consideration of the statement in the J.B. Marketing, Inc. brochure that the tattoos are "incredibly realistic...looks just like a real tattoo". Real tattoos generally have a matte appearance.

The brochures show temporary tattoos representing logos, team mascots and letters. The shape of the design for Figures 6 and 7 of the present application is shown in the Team Dynamics brochure, available in black as item A-64-8, and is shown in the "Anderson's" brochure, available as item 33A64.

Appellants argue that the temporary tattoos are typically not dull, matte, non-reflective and are not dimensioned or positioned so as to cover the area of reflective light location on a wearer's cheek.

Appellants' statements regarding the appearance of real tattoos and association with "low class and/or motorcycle gang individuals" has been considered but is not persuasive with respect to the patentability of the present invention.

With respect to the limitations regarding size, reflectivity and dimensions so as to substantially eliminate reflection and to substantially cover a reflective location, these limitations are indefinite and place no positive limitations on the size or material of the tattoos. As apparent from the brochures,

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particularly the brochure from J.B. Marketing, tattoos can be custom designed in any size, shape and color that a purchaser may desire (note the page headed "Custom Design Program").

Appellants argue that not one of the illustrated tattoos or decals is illustrated and/or colored so that it will function in the manner set forth in the claims. Appellants question why, if the invention were obvious, does the literature not illustrate the use as according to the present invention? Appellants question why, if it's so obvious, isn't the logo or name of a sports apparel or equipment manufacturer or distributor provided? Again, note the J.B. Marketing, Inc. brochure regarding custom design. Also, it is important to note that there are legal matters, such as licensing requirements, involved in utilizing a trademarked name or logo. From an monetary standpoint, it may be economically advantageous for a manufacturer of temporary tattoos to avoid making tattoos which would require licensing fees to be paid, particularly when there are numerous tattoos which could be made without incurring the excess cost. This does not mean that utilizing a name or logo is not an obvious design modification for a temporary tattoo.

Appellants argue that none of the positions shown in the brochure will prevent incident light from being reflected into the eyes. This argument is not relevant for claims 17-19 because the intended use of the tattoo places no positive limitations on

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the structure of the claimed product. The intended use for the product does not patentably distinguish the product from that of the prior art.

With respect to the brochures cautioning to avoid positioning near the eye or on sensitive skin, this caution against use near eyes can easily be explained. The commercially available tattoos are made of non-toxic materials, so that is not a problem as far as application near the eye. However, imagine if someone accidentally scratched his/her cornea by poking his/her eye with the tattoo material while applying it. Or, imagine someone accidentally getting rubbing alcohol in his/her eye when removing the tattoo. Now imagine if the tattoos carried no warning and imagine the law suit that would result because "nobody told me". There is nothing in the present claims to distinguish the temporary tattoos from those of the prior art. Besides, just because someone is told not to do something doesn't mean it won't ever be done.

Appellants argue that claims 1 and 17 call for a "non-reflective colored and finished" material, stating "Even if matte, real tattoos may have reflectively colored portions". The examiner points out that the claims do not exclude reflectively colored portions.

With respect to appellants' argument that no one has previously thought of the participants of an athletic contest

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using temporary tattoos, aren't fans and cheerleaders participants, *per se*, in an athletic contest?

(10) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.


(11) *Response to argument.*

The Examiner's position with regard to Appellants' arguments is as set forth above in "*Grounds of Rejection*".

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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APPENDIX - CLAIMS ON APPEAL

8. A method as recited in claim 2 wherein step (a) is practiced to provide as the clearly demarcated predefined geometric shape a sports apparel or equipment manufacturer's or distributor's logo,.

9. A method as recited in claim 2 wherein step (a) is practiced to provide as the clearly demarcated predefined geometric shape a sports apparel or equipment manufacturer's or distributor's logo and/or letters identifying the manufacturer or distributor within a primarily black or dark colored area, and sized to comply with regulations of any regulatory body which oversees the athletic contest.

18. A decal or temporary tatoo as recited in claim 17 wherein the clearly demarcated geometric and predefined shape is a sports apparel or equipment manufacturer's or distributor's logo and/or letters identifying the manufacturer or distributor.